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Epic Systems Corporation
c/o Quarles & Brady LLP
411 E. Wisconsin Avenue
Milwaukee, WI 53202

EXAMINER

MORGAN, ROBERT W

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL DVORAK,
KHIANG SEOW, and
CHARLES YOUNG

Appeal 2010-002993
Application 10/052,659
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Carl Dvorak, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-8 and 14-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to “a system for distributed computing in a health care environment.” Specification [0005].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. In a system for distributed computing in a health care environment in which multiple different applications are in use connected on a common computer network, the improvement comprising

a clinical exchange server on the network, the clinical exchange server including memory, the clinical exchange server programmed (i) to maintain a patient identification cross reference table, the patient identification cross reference table including a list of applications on the network and patient identification numbers used by each application wherein the patient identification numbers used by the applications are application distinct patient identification numbers for the patient, wherein the application distinct patient identification numbers for the patient include a first patient identification number used by a first application and a second patient identification number

¹ Our decision will make reference to the Appellants’ Appeal Brief (“Br.,” filed Sep. 1, 2009) and the Examiner’s Answer (“Answer,” mailed Sep. 28, 2009).

used by a second application where the second patient identification number is different than the first patient identification number, (ii) to maintain a list of events reported to it by other applications on the network and (iii) to respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the reference table and the list of reported events.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Smithies	US 5,544,255	Aug. 6, 1996
Felsher	US 2002/0010679 A1	Jan.24,2002
Moragne	US 2005/0102374 A1	May 12, 2005

The following rejection is before us for review:

1. Claims 1-8 and 14-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moragne, Felsher, and Smithies.

ISSUE

Did the Examiner err in rejecting claims 1-8 and 14-20 under 35 U.S.C. §103(a) over Moragne, Felsher, and Smithies?

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

The Appellants argued claims 1-4 as a group (Br. 5). We select claim

1 as the representative claim for this group, and the remaining claims 2-4 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 1 is drawn to an apparatus comprising a computer network and a server. Specifically, claim 1 provides for an improvement to a distributive computing system whereby a server with a memory is programmed to do three things: (i) maintain a table with a list of applications on the network and a list having two different patient-specific numbers that correspond to two distinct applications that use them respectively; (ii) maintain a list of events reported to the server by other applications on the network; and (iii) respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the table (see (i)) and the events list (see (ii)).

The Examiner takes the position that Moragne discloses the claimed distributive computing system but for the recited server. In that regard, the Examiner relies on Felsher, citing [0266]-[0268] and [0279]. According to the Examiner, Felsher discloses a server programmed to maintain a table, maintain a list of events, and respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the table and the events list. Answer 4.

Felsher is directed to an information record infrastructure for maintaining, in particular, medical records. As is typical, such records have been stored in a database on a server. See e.g., [0063]. Felsher seeks to improve on such systems so that confidentiality of those records are maintained - by employing a certification authority, encryption, and

passwords. [0279]. At [0266], Felsher describes a database architecture “that provides data relating to patient transactions. ... Each transaction is indexed by patient identifier.” According to [00267], a transaction may be a record containing any type of medical-related data. [00268] discloses a central index “for each patient, the location of the transactions and access rules therefor.” The index relates patient identifier with database records. See [0279].

The Appellants dispute that Felsher discloses a server programmed to maintain a cross-reference table as claimed. Br. 6.

The cross-reference table as claimed contains two pieces of information: (a) a list of applications and (b) numbers used by each application (“patient identification numbers”). According to the claim, the numbers comprise two different numbers: a first number (“first patient identification number used by a first application”) used by a first application and a second number (“second patient identification number) used by a second application.

By contrast, Felsher discloses an index with transactions related to patient identifiers.

Felsher would lead one of ordinary skill in the art to a server with a database to maintain an index of data representing different types of medical information that can be related or cross-referenced to each other.

Accordingly, the question boils down to whether Felsher’s index would lead one of ordinary skill in the art to the claimed table.

The Appellants do not explain the patentable distinction between an “index” as Felsher calls it and a “table” as that term is used in the claims and

it is not readily apparent. At best, a “table” refers to the form the data is to be placed in. In that regard, indexes in the form of a table are well known to those skilled in the art and given that Felsher’s index resides in a database, which conventionally orients records in the form of tables (e.g., spreadsheets), it would have been obvious over Felsher’s index to maintain records in the form of a table.

We are equally unpersuaded that Felsher fails to disclose or render obvious maintaining a table of list of applications and numbers. Again, the Appellants do not explain the patentable distinction between an “index” as Felsher calls it and a “list” as that term is used in the claims and it is not readily apparent. In fact, an index is ordinarily understood to mean a list. The ordinary and customary meaning of “index” is a list, e.g. “an alphabetical list of names, [etc.]” (*See Webster’s New World Dictionary* 686. (3rd Ed. 1988.)(Entry 4 a) for “list.”)

As to the difference between the claimed table listing applications and numbers used by each application where the numbers comprise two different numbers: a first number used by a first application and a second number used by a second application as claimed and Felsher’s index of “transactions” and patient identifiers related to each other, it appears to be a matter of nonfunctional descriptive material. Both the claimed system and that of Felsher comprise servers programmed to maintain information. The difference is in the type of information the claimed server maintains as compared to the type of information Felsher is maintaining. There is otherwise no difference between the servers. The fact that the claim requires a list of “applications” and “numbers” does not change the fact that it is list

of data maintained on the server. The difference between data representing “applications” and “numbers” maintained on the server of the claimed system and data representing “transactions” and “identifiers” as stored in Felsher’s database is a matter of a difference in the informational content of the data. That informational aspect of the data which is characterized as “applications” and “numbers” is properly considered to be nonfunctional and descriptive. Also, the Appellants have not come forward with evidence sufficient to show that the structure of the data is functionally affected by it being, specifically, an “application” and/or “number”. Absent such evidence, it is reasonable to conclude that the “application” and “number” aspect of the maintained data is descriptive and not functionally related to any structure of the claimed invention and as such falls under the category of patentably inconsequential subject matter. See *Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) (“Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in

the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.).” See also *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative).

The Appellants also argue that “Felsher clearly does not teach or suggest that a second query is generated for a second application in response to reception of a first query at an exchange server.” Br. 6. However, this is not precisely what claim 1 calls for. Claim 1 calls for a server programmed to “respond to inquiries from a first application ... by transmitting a query to the second application.” Claim 1 does not necessarily require *generating a second query for* a second application in response to reception of a *first* query. Claim 1 reasonably broadly covers transmitting a query *per se* to a second application in response to an inquiry from a first application.

Be that as it may, the question is whether it would have been obvious over the cited prior art combination to transmit a query to a second application in response to an inquiry from a first application. The Specification uses the term “application” to mean programs. See [00026]. Accordingly, the issue is whether it would have been obvious over the cited prior art combination to transmit a query to a second program in response to an inquiry from a first program.

The Examiner cited the passage at [0264] of Felsher is support of finding that Felsher discloses transmitting a query to a second application in response to an inquiry from a first application. Answer 4. The Appellants agree that Felsher “teaches a system that includes a custodian medical record system that renders records related to medical transactions (see paragraph

264) available to different applications.” Br. 6. But, the Appellants argue, only “a single query is provided to the custodian system (see paragraph 264) and the custodian system can use the index to directly access the record in the database.” Br. 6. We disagree. [0264] of Felsher describes a trustee system by which a recipient’s query for a medical record within the custodian network is transmitted from the recipient to a trustee system and then to the custodial system. Accordingly, it describes a system programmed to transmit a query per se to a second application (i.e., Felsher’s trustee system) in response to an inquiry from a first application (i.e., Felsher’s custodial system) as claim 1 is reasonably broadly construed.

The Appellants further argue that even if Felsher would lead one to a system programmed to transmit a query to a second application in response to an inquiry from a first application, Felsher does not do so “based on the information in the reference table and the list of reported events” (claim 1). Br. 7. We disagree. The system as claimed does not require the server to perform any action to access information in the server and then use that particular information to generate a second query. The system as claimed requires only that the server transmit a query to a second application “based” on such information. In that regard, Felsher’s custodial system transmits a recipient’s query for a medical record it has received to a trustee system. Given that such a query necessarily seeks information stored in the system’s medical records database, Felsher custodial system transmits a recipient’s query for a medical record it has received to a trustee system “based” on such information. Also, the Appellants’ construction of the claim is too narrow - the system as claimed is not limited to transmitting a *second* query

different from a *first* query. Claim 1 is reasonably broadly construed to cover transmitting to the second application the same query made to the first application. As we previously explained, Felsher describes a trustee system by which a recipient's query for a medical record within the custodian network is transmitted from the recipient to a trustee system and then to the custodial system. This disclosure would lead one to a server programmed "to respond to inquiries from a first application about an event recorded by a second application by transmitting a query to the second application based on the information in the reference table and the list of reported events" as claimed.

Finally, the Appellants challenge the relevance of Smithies. According to the Appellants, "Smithies fails to teach or suggest what the other references lack." Br. 8. First, "Smithies fails to teach or suggest a reference table like the one in claim 1 that includes both a list of applications and associated patient identifiers." Br. 7-8. And, second, "Smithies fails to teach or suggest responding to an inquiry from a first application by transmitting a query to a second application based on information in the reference table (i.e., based on the application list and associated or corresponding patient identifiers in the table)." Br. 8-9. We have already addressed these two arguments with respect to what Flesher discloses and found them unpersuasive. Accordingly, we are not are not persuaded by these arguments directed at Smithies alone that the *prima facie* case of obviousness for the claimed subject matter over the cited prior art combination as a whole was established in error.

Accordingly, we affirm the rejection of claim 1 and the claims 2-4

which stand or fall with it.

As to claims 5-8 and 14-20, the Appellants state merely that “each [of independent claims 5, 14, 18, 19, and 20] is believed to be non-obvious for essentially the same reasons described above with respect to claim 1.” Br. 9.

Since we found the arguments challenging the rejection of the “system” claims 1-4 unpersuasive, given no other argument, we find them equally unpersuasive, for the same reasons, as to error in the rejection of the “computer network” claims 5-8 and “system” claims 19 and 20.

Claims 14-18 are, however, method claims. Though arguments in favor of the patentability of apparatus claims do not necessarily apply to method claims (*see Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (“apparatus claims cover what a device is, not what a device does.”)), here no argument separately challenging the rejection of method claims 14-18 has been provided. *Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112 (2d Cir. 1999) (“Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”) Accordingly, since we found the arguments challenging the rejection of the “system” claims 1-4 unpersuasive, given no other argument, we find them equally unpersuasive, for the same reasons, as to error in the rejection of the “method” claims 14-18.

DECISION

The decision of the Examiner to reject claims 1-8 and 14-20 is affirmed.

Appeal 2010-002993
Application 10/052,659

AFFIRMED

MP